Docket No.: R2184.0095/P095
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hirotsugu Satoh

Application No.: 09/783,553 Confirmation No.: 9369

Filed: February 15, 2001 Art Unit: 2192

For: OPTICAL RECORDING MEDIUM Examiner: M. J. Yigdall

REQUEST FOR RECONSIDERATION

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The application has been reviewed in light of the rejection dated March 2, 2006. Claims 1-5 are pending in the application. Applicant reserves the right to pursue the original claims and other claims in this and other applications.

Claims 1 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mochizuki (US 6,097,814) in view of Tognazzini (US 6,600,713), and further in view of Miller et al. (US 6,535,911). This rejection is respectfully traversed. In order to establish a *prima facie* case of obviousness "the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. §2142. None of Mochizuki, Tognazzini, nor Miller et al., even when considered in combination, teach or suggest all limitations of independent claim 1.

Claim 1 recites, *inter alia*, an optical recording medium "which ... stores software to be distributed, non-rewritable inherent ID information, a transmission program for transmitting the inherent ID information to a software distributor via a communication device, and a program for causing updated software to be stored in a memory device of a computer and in said optical recording medium" (emphasis added). As noted in the Office Action, Mochizuki does not teach or suggest such a limitation. Nor does Tognazzini teach or suggest this limitation.

To the contrary, Tognazzini teaches that "[p]rogramming which instructs the CPU 400 to operate in accordance with the present invention as will be described in detail below may be stored in ROM or RAM." Col. 5, ln. 24-26. Applicant respectfully submits that Tognazzini does not disclose, teach, or suggest a program stored on the optical recording medium for causing updated software to be stored in a memory device of a computer and in the optical recording medium as recited in claim 1. Nor is Miller et al. cited for this limitation. Thus, Miller et al. does not remedy the deficiencies of Mochizuki or Tognazzini.

Moreover, M.P.E.P. §2143 delineates the three criteria for establishing a *prima facie* case of obviousness as: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. The Office Action has failed to make a *prima facie* case of obviousness under this M.P.E.P. provision. None of the cited references contain a suggestion or a motivation for their combination. None of the references sets forth a reasonable expectation of success in their combination. The Office Action does not identify where a suggestion to combine the references exists or why a reasonable expectation of success of combining the references exists. Rather,

information contained in the current application is impermissibly used, in hindsight, to pick and choose features of the references to combine to arrive at the present invention.

Since Mochizuki, Tognazzini, and Miller et al. do not teach or suggest all of the limitations of claim 1, claim 1 and dependent claim 4 are not obvious over the cited references. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 1 and 4 be withdrawn.

Claims 2-3 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mochizuki in view of Shaw (US 6,381,741), in view of Tognazzini, and still further in view of Miller et al. This rejection is respectfully traversed.

Claims 2 recites, *inter alia*, an optical recording medium "which ... stores software to be distributed, non-rewritable inherent ID information, and a software updating program for causing updated software to be stored in a memory device of a computer and in said optical recording medium" (emphasis added). None of Mochizuki, Shaw, Tognazzini, nor Miller et al. teaches or suggests this limitation.

As noted in the Office Action, Mochizuki does not teach or suggest such a limitation. Nor does Shaw teach or suggest this limitation. To the contrary, Shaw teaches that "downloader code 24 is stored within permanent memory 14 and is a secure set of code which controls the connection of client device 10 via I/O port 40 to a communication channel 50." Col. 2, ln. 58-61. Permanent memory 14 is a Read-Only Memory within the client computer 10. Col. 2, ln. 39-46. Applicant respectfully submits that Shaw does not disclose, teach, or suggest a program stored on the optical recording medium for causing updated software to be stored in a memory device of a computer and in the optical recording medium as recited in claim 2. Thus, Shaw does not remedy the deficiencies of Mochizuki.

Nor does Tognazzini teach or suggest this limitation. To the contrary, as discussed above, Tognazzini teaches that "[p]rogramming which instructs the CPU 400 to operate in accordance with the present invention as will be described in detail below may be stored in ROM or RAM." Col. 5, ln. 24-26. Applicant respectfully submits that Tognazzini does not disclose, teach, or suggest a program stored on the optical recording medium for causing updated software to be stored in a memory device of a computer and in the optical recording medium as recited in claim 2. Nor is Miller et al. cited for this limitation. Thus, Tognazzini and Miller do not remedy the deficiencies of Mochizuki or Shaw.

Since Mochizuki, Shaw, Tognazzini, and Miller et al. do not teach or suggest all of the limitations of claims 2, claim 2 is not obvious over the cited references. Claims 3 and 5 recite limitations similar to those discussed above in connection with claim 1 and should be allowable along with claim 2 and for other reasons. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 2-3 and 5 be withdrawn.

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Dated: June 1, 2006

Respectfully submitted,

By _____

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